

Applicant: Cathleen Siok-Syuan Chua
Serial No.: 10/814,888
Filing Date: March 30, 2004
Docket No.: CCH-001

REMARKS

Reconsideration and allowance are respectfully requested.

Claims 5-11 and 14-18 are canceled in this amendment.

Claims 19-25 are pending, of which Claims 19-24 are allowed. Dependent Claim 25 is newly added.

Claim 17 (and its dependent claims)

The Patent Office has done a considerable injustice to a small inventor and entrepreneur who is trying to build a business. The invention is a nifty and inventive item. See the website www.cc3design.com. This patent application is not going to result in just a paper patent. The inventor has built a little business and is trying to protect it. The inventor does not, however, have the resources and money to continue to try to explain why her claims are distinguished from prior art the Examiner has cited. She now is being forced to accept much limited patent protection that will not include any apparatus claim, not because her apparatus claims are unpatentable over the prior art, but because the Patent Office has unreasonably beaten the inventor down and used up her resources. The undersigned wants to continue on and to prevail in obtaining her the scope of protection she deserves and is entitled to under the Patent Laws, but the inventor cannot afford to continue in this expensive process. That is a shame.

The Examiner is requested to reconsider his position. The Examiner has the power and authority to reverse himself.

The Office Action of November 29, 2006, states that Claim 17 would be allowable if rewritten to overcome a §112 issue. Applicant amended Claim 17 to eliminate the §112 issue. The Applicant canceled her pure apparatus claims that defined a clearly different and non-obvious structure so that she would obtain a Notice of Allowance in the next office action including some form of apparatus claim (Claim 17). To the inventor's dismay, rather than allowing the application, the Examiner has now backtracked and rejected Claim 17. The instant Office Action of March 8, 2007 states that "the indicated allowability of claim 17 & 18 is

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withdrawn in view of the newly discovered reference(s) to Bailey (U.S. Patent Number 6817033 B2). Rejections based on the newly cited reference(s) follow.” (Office Action, page 8, lines 15-17).

The reason the Examiner gives for now rejecting Claim 17 is not true. Bailey (USP 6,817,033) is not a newly discovered reference. It has been discussed at length in the record. What is the Examiner doing? The statement concludes saying that “rejections based on the newly cited reference(s) follow”, but this is also false. There is no rejection that follows. Indeed, the newly cited references are considerably more different from the claimed invention than is Bailey. The newly cited references are weak and it is not seen how such references, taken either alone or in combination with any other reference of record, could possibly justify the Examiner’s actions in withdrawing the indicated allowability of Claim 17.

With respect to Bailey, the instant Office Action rejects Claim 17 under 35 U.S.C. §103 over a single reference, the same old Bailey reference (USP 6,817,033). Quite tellingly, the Examiner acknowledges that “Bailey does not disclose extension arms that wrap around at least portion of the front-worn baby carrier . . .” (Office Action, page 3, lines 5-13). Applicant agrees. There is nothing in Bailey that discloses or remotely suggests arms that wrap around a baby carrier.

The Examiner, however, decides to ignore Claim 17’s preamble and states “The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Bailey (U.S. Patent Number 6817033 B2) which is capable of being used in the intended manner...” (Office Action, page 3, lines 5-13). The Office Action then directs the reader to MPEP 2111.

Applicant respectfully disagrees with this reading of Claim 17. First, why is the Examiner now for the first time reading this claim this way? Doing so has harmed the inventor’s interests. The new way the Examiner is reading Claim 17

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has nothing to do with any “newly cited reference”. Second, contrary to the Examiner’s assertion, the preamble statement of Claim 17 is NOT A STATEMENT OF INTENDED USE. A statement of intended use would be “A baby blanket intended for use with a front-worn baby carrier” or perhaps “A baby blanket for use with a front-worn baby carrier.” That is not what Claim 17 says. Claim 17 says “A baby blanket that is operable with a front-worn baby carrier” (emphasis added). That is a statement of functionality and structure, not a statement of the intent of a person. What makes an object “operable with”, reasonably construed, is a structural aspect of the object. Nothing in MPEP 2111 supports the Examiner’s position. In fact, one case set forth in MPEP 2111, states “[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention...”.¹ That is what the undersigned thought and assumed the Examiner was doing when the Examiner originally indicated Claim 17 was allowable but rejected the other independent apparatus claims that did not have such a preamble. Third, despite what the Examiner says, Bailey is not reasonably “operable with a front-worn baby carrier” as specifically recited in the preamble of Claim 17 and in the last “second arm extension” recitation. The Examiner’s attention is directed to Bailey Figures 1 and 2. Those very large elephant ear-shaped “wings”² would result in a large amount of material being jammed between the person and the front-worn baby carrier. It would appear to be bulky, difficult to do, and uncomfortable. Moreover, tying those round elephant ear-shaped wings together would appear to be exceedingly difficult to do because they are round. It is submitted that when Bailey is objectively considered, Bailey is not “operable with a front-worn baby carrier” as recited in Claim 17 where the arm extension portions cross over one another “at a location

¹ *Catalina Mktg. Int'l v Coolsavings.com*, 62 USPQ2d at 1785.

² Dependent Claim 7, that recites Applicant’s extension portions have “a substantially triangular shape”, clearly distinguishes the round elephant ears of Bailey.

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between the person and the front-worn baby carrier” so that they are “detachably connected on the other side of the front-worn baby carrier with respect to the person” as recited in the last element of Claim 17. Applicant’s Claim 17 is to be read as a whole, and Applicant is clearly relying on the preamble during prosecution pursuant to Catalina Mktg and MPEP 2111, thereby under the law making the preamble a certain limitation. Bailey does not fall within the scope of Claim 17. The §103 rejection, that is based on but one reference, is improper and unreasonable. Reconsideration is requested.

Unfortunately, Applicant is forced to cancel Claim 17 now in order to obtain a Notice of Allowance in the next office communication. If, however, the Examiner reconsiders and finds Applicant’s explanation convincing, then the Examiner is requested to contact the undersigned at (925) 862-9972 so an agreement can be reached as to how to reinstate the canceled claim. An Examiner’s amendment that adds a new claim having identical wording to Claim 17 is a possibility. This is not an adversarial process. The Examiner is implored to assist the inventor in obtaining patent protection.

Claims 19-24

Claims 19-14 are allowed.

Claim 25

Dependent Claim 25 further defines the “blanket” that is involved in one example of the method of Claim 19. The Examiner’s attention is directed to Figure 3 of Applicant’s specification, entitled “Front View”, for an example of a blanket that satisfies the recitations of Claim 25. Notice locations A, B, C and D. The Examiner’s attention is also directed to the associated text in Applicant’s specification. A markup of Figure 3 is provided on the next page.

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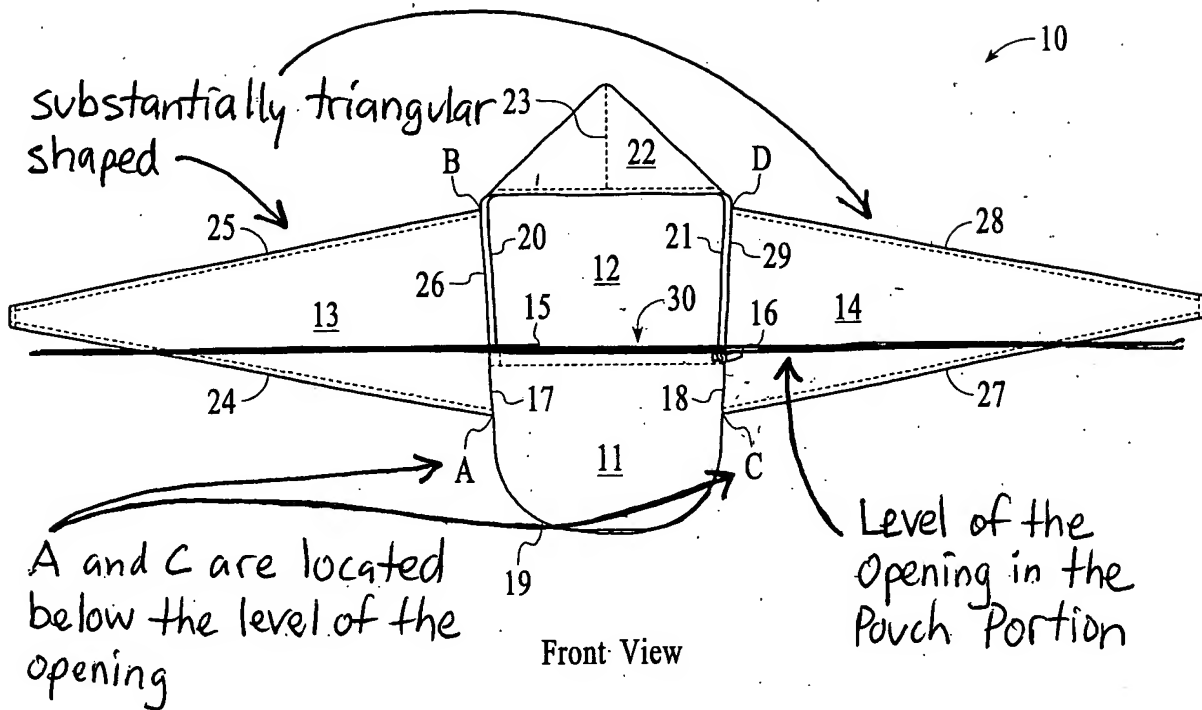


FIG.3

It is to be understood, however, that the blanket of Figure 3 is but one specific example of a blanket that meets the recitations of new Claim 25. Allowance of dependent Claim 25 is requested.

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Conclusion

In view of the above amendments and Remarks, it is believed that this application (Claims 19-25 are pending) is in condition for allowance. A Notice Of Allowance is respectfully requested. If the Examiner would like to discuss any aspect of this application, the Examiner is requested to contact the undersigned at (925) 862-9972.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By T. Lester Wallace
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Respectfully submitted,

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